



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/834,078	04/12/2001	Nobukazu Suzuki	1232-4706	2751

27123 7590 07/01/2005

MORGAN & FINNEGAN, L.L.P.  
3 WORLD FINANCIAL CENTER  
NEW YORK, NY 10281-2101

EXAMINER

LEE, CHEUKFAN

ART UNIT	PAPER NUMBER
----------	--------------

2622

DATE MAILED: 07/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<p align="center"><b>Office Action Summary</b></p>	<b>Application No.</b> 09/834,078	<b>Applicant(s)</b> SUZUKI, NOBUKAZU	
	<b>Examiner</b> Cheukfan Lee	<b>Art Unit</b> 2622	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on March 14, 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 22-31 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 22-29 is/are allowed.
- 6) ☒ Claim(s) 30 and 31 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 April 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                                   | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>3/14/05, 3/31/05</u>  | 6) <input type="checkbox"/> Other: _____                                    |

Art Unit: 2622

1. Claims 22-31 are pending. Claims 22, 29, 30, and 31 are independent.

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 30 and 31 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claim 30 recites in the preamble "A memory medium which stores a program for controlling an image reading apparatus having ...". The "memory medium", which stores the program, can be any medium that can store a program, such as a piece of paper or a wall on which the program is written. Further, there is no program, but "the method" is claimed. Thus, in order for the claim to be in a proper format not to be subjected to a 101 rejection, the preamble should be changed to read as follows:

-- A computer-readable storage medium which stores a program for performing a method of controlling an image reading apparatus having ... at least two power sources, the method comprising: --

Claim 31 recites in the preamble "A program for controlling an image reading apparatus having ...". The "program", without being a computer program embodied in a computer-readable storage medium for performing the method, is non-statutory subject matter. In the present case, the proper preamble should read as follows:

Art Unit: 2622

-- A computer program embodied on a computer-readable storage medium for performing a method to control an image reading apparatus having ... at least two power sources, the method comprising: --

4. Claims 22-29 are allowed.

5. The following is an examiner's statement of reasons for allowance:

Apparatus claim 22 and corresponding method claim 29 are allowable over the prior art of record because the prior art does not teach, in an image reading apparatus, an operation mode setting unit arranged to set one of the plurality of operation modes that require different consumption powers, in accordance with a power source the power supply of the apparatus uses, the power source being selected from at least two power sources, and a shading correction unit using calibration data that corresponds to the set operation mode to perform shading correction of image data obtained by the original image reader of the apparatus.

Claims 23-28 depending on claim 22 are allowable for the reason given for claim 22.

Please note that although the Japanese prior art reference (JPA 61-133766), cited by Applicant in the Information Disclosure Statement filed March 14, 2005, teaches setting of an operation mode in accordance with the power source being used in the apparatus, the reference does not teach a combination of the operation mode

Art Unit: 2622

setting unit and the shading correction unit. That is, the reference does not each using calibration data that corresponds to the operation mode, set by the operation mode setting unit that sets the operation mode in accordance with the power source being used, to perform shading correction on the image data obtained from the image reader.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cheukfan Lee whose telephone number is (571) 272-7407. The examiner can normally be reached on 9:30 a.m. to 6:00 p.m., Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward L. Coles can be reached on (571) 272-7402. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 2622

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Cheukfan Lee  
June 20, 2005

  
*Cheukfan Lee*